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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,718

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EXAMINER

JUEDES, AMY E

ART UNIT

PAPER NUMBER

1644

MAIL DATE

DELIVERY MODE

04/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,718	Applicant(s) ROY ET AL.	
	Examiner AMY E. JUEDES	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-81 is/are pending in the application.
- 4a) Of the above claim(s) 53-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/10/07, 6/5/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of the species of the compound of formula I, in the reply filed on 12/19/08 is acknowledged.

Claims 53-81 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 49-52, as they read on the elected species of the compound of formula I, are being acted upon.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 49-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Brasseur et al., 2000, Photochem. and Photobiol (of record).

Brasseur et al. teach a composition comprising PDT treated tumor cells. Brasseur et al. teach treating the cells with the photosensitizer 4,5-dibromorhodamine methyl ester (TH9402), i.e. the compound of formula I. Brasseur et al. teach activating the compound by exposing the cells to light centered around 515 nm (see page 781, in particular). Furthermore, the recitation of an "immunologic vaccine" refers to an intended use of the claimed PDT-treated cells, and does not carry patentable weight in the absence of a structural difference. The PDT treated cells of Brasseur et al. are structurally identical to the PDT treated cells of the instant claims.

Thus, the reference clearly anticipates the invention.

4. Claims 49-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Roy et al., 2000, Blood.

Roy et al. teach a composition comprising PDT treated blood stem cells. Roy et al. teach treating the cells with the photosensitizer TH9402 (i.e. the compound of

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formula I, which is inherently a compound activatable by light having a wavelength of about 450 to 600nm). Furthermore, Roy et al. teach administering the PDT treated cells to a cancer subject (i.e. an "immunologic vaccine").

Thus, the reference clearly anticipates the invention.

5. Claims 49-52 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/24824 (of record).

WO 01/24824 teaches a composition comprising cells treated with a photoactivatable compound of formula I. WO 01/24824 teaches activating said compound with light of a wavelength of around 512 nm (see pages 10-11 and 21, in particular). WO 01/24824 also teaches administering the PDT cells to treat immunologic disorders (i.e. an "immunologic vaccine", see pages 10-11, in particular).

Thus, the reference clearly anticipates the invention.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 49-52 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 25 of copending Application No. 10/969,011. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '011 application claims treating hematopoietic cells with a photoactivatable compound of formula I, irradiating the cells with a light of suitable wavelength, (i.e. PDT treated cells). The '011 application also claims administering the cells to a patient as a stem cell transplant (i.e. an "immunologic vaccine").

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. No claim is allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E. Juedes whose telephone number is 571-272-4471. The examiner can normally be reached on 7am to 3:30pm, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen O'Hara can be reached on 571-272-0878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy E. Juedes

Patent Examiner

Technology Center 1600

/Amy E. Juedes/

Examiner, Art Unit 1644